

## **REMARKS**

An interview was held with Examiner Alicia M. Harrington to address inconsistencies and typographical errors of the pending office action (paper no. 20080121). Referring to the Examiner Interview Summary of March 5, 2008, filed electronically on the PTO web-site on March 6, 2008, the reference to the following should be corrected as shown: claims 28-31, 33-35, 38, 41-42 44-46 are rejected under 35 U.S.C. 102 as being anticipated by Guirao et al. (US 6,511,180). That is, claims 44-46 should not have been included in this rejection and claims 41-42 should have been. Moreover, the Examiner states that on page 4 of the pending office action (paper no. 20080121) that the first word to "Guirao" is a typographical error and should be replaced with "Lia."

New claim 47 is added. Support for the new claim is provided by exemplary disclosures of the inventions of the originally-filed application at, for example, pages 11-12 and 15-16.

Claims 28-31, 33-35, 38, 41-42 44-46 are rejected under 35 U.S.C. 102 as being anticipated by Guirao et al. (US 6,511,180). Claims 36, 37, 44-46 are rejected under 35 U.S.C. 103 as being unpatentable over Guirao. Claims 28-33, 36-37 are rejected under 35 U.S.C. 103 as being unpatentable over Lai (US 6,836,371). Claims 38 and 39 are rejected under 35 U.S.C. 103 as being unpatentable over Lai in view of Perrott '337 (US 2002/0118337). Claim 40 is rejected under 35 U.S.C. as being unpatentable over Lai and Abitbol (US 2002/0196412). Claim 43 is rejected under 35 U.S.C. 103 as being unpatentable over Lai in view of Morris (US 5,454,408).

Independent claim 28 is amended to recite “wherein the modifying comprises providing at least one refracting surface of the lens that performs dioptric correction of the ametropia and performs correction of the at least one aberration of the higher order for at least one direction of view, and wherein the percentage of the at least one aberration of higher order is compensated by correcting only central aberrations.” Support for the amendment language is provided by exemplary disclosures of the inventions of the originally-filed application at, for example, pages 15-16. The art of record, singularly or in any combination, fails to teach or suggest “wherein the percentage of the at least one aberration of higher order is compensated by correcting only central aberrations.” The Examiner is reminded that the originally-filed application disclosed that central aberrations include sphere, cylinder and axis which was recited in the original claim 8. Regarding Guirao, such reference teaches use of a subset of aberrations for optimizing the image (optical image quality) by incorporating various metrics. That is, Guirao does not teach the “aberration of higher order is compensated by correcting only central aberrations” as positively recited by claim 28.

Regarding Lia, such reference teaches low order and/or high order aberrations, respectively, and combinations thereof are corrected. That is, there is no teaching to a correction of high order by modifying the aberrations of central aberrations. Accordingly, it is inconceivable that Lia teaches “aberration of higher order is compensated by correcting only central aberrations” as positively recited by claim 28. Respectfully, the Examiner is reminded that to establish *prima facie* obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art. MPEP §2143.03 (8<sup>th</sup> edition) *citing In re Royka*, 490 F.2d 981, 180 USPQ 580

(CCPA 1974). Since neither reference, singularly or in any combination, teaches the above-recited limitation of claim 28, independent claim 28 is allowable.

Claims 29-43 and 47 depend from allowable independent claim 28, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

Independent claim 44 is rejected as being obvious over Guirao. Claim 44 recites “wherein at least 50%, preferably at least 75%, of said aberrations of higher order are compensated solely by a correction of said central aberrations such as sphere, cylinder and axis.” Guirao teaches that any subset of the measured aberrations (low and high) is used to improve the image quality. However, Guirao does not teach to a compensation of higher order aberrations. That is, Guirao does not teach the “said aberrations of higher order are **compensated solely by** a correction of said central aberrations such as sphere, cylinder and axis” as positively recited by claim 44. For this reason alone, claim 44 is allowable over Guirao.

Moreover, regarding the claim 44 recitation to wherein at least 50%, preferably at least 75%, of said aberrations of higher order ...,” the art of record fails to teach percentages of compensation. In fact, the Examiner tacitly states the art fails to teach the positively recited percentages and relies on a 1955 CCPA case (*In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)) to state that “where the general conditions of the claim are disclosed in the prior art, discovering an optical workable ranges (sic) involves only routine skill in the art.” First, the Examiner is misapplying case law without finishing the analysis to make applying case law appropriate. Second, the Federal Circuit Court has, with recent case law, clearly stated that it is the duty of

the Examiner to come forward first and point out teachings of the art of record of an overlap of ranges (percentages) to establish a *prima facie* case of obviousness.

First, regarding finishing the analysis to make applying case law appropriate, the Examiner is respectfully reminded that the MPEP states regarding legal precedent: “**If the facts** in a prior legal decision are **sufficiently similar** to those in the application under examination, [only then can] the examiner [] use the rationale used by the court” (emphasis added) MPEP §2144 and §2144.04. The *Aller* decision is directed to “a change in temperature, or in concentration, or in both” *Aller* at page 235. That is, the facts of *Aller* are directed only to temperatures or concentrations, and Applicant’s claims are not directed to temperatures or concentrations. Accordingly, for proper application of this case law, and as clearly stated by the MPEP, since the facts between *Aller* and Applicant’s claimed invention are not similar, the Examiner’s reliance on *Aller* is improper and must be withdrawn. For this additional reason, claim 44 is allowable over Guirao.

Furthermore, with regard to ranges, the Federal Circuit Court in *In re Harris* reiterates that the first burden is on the Examiner to establish a *prima facie* case of obviousness and then defines what a *prima facie* case of obviousness for claimed ranges is:

The PTO has the burden of showing a *prima facie* case of obviousness. *Mayne*, 104 F.3d at 1341. In this type of claim, a *prima facie* case of obviousness arises when the ranges of a claimed composition **overlap the ranges disclosed in the prior art**.

*In re Harris*, 409 F.3d 1339, 74 USPQ2d 1951, 1953 (Fed. Cir. 2005) (emphasis added).

The *In re Harris* case then cites to a wealth of Federal Circuit cases, for this statement: "See *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir 2003); *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir 1997); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990)." The Examiner cannot ignore this 2005 case and simply rely on a self-serving statement of a 1955 case which has been clearly clarified by subsequent and very recent Federal Circuit Court decisions. Since the Examiner provides absolutely no teachings of percentages as positively recited in claim 44, no *prima facie* case of obviousness has been established pursuant to this recent authority of the Federal Circuit Court. The Examiner must present some overlap of percentage taught by the art to establish a *prima facie* case of obviousness. Having not done so, the obviousness rejection against claim 44 is improper and must be withdrawn. For this reason alone, independent claim 44 is allowable over Guirao.


No other rejection is presented against independent claim 44, and therefore, independent claim 44 is allowable.

Claims 45-46 depend from allowable independent claim 44, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

This application is now believed to be in immediate condition for allowance and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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